

### **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the prior Office Action. No amendments are believed to be necessary to place the application into condition for allowance. Accordingly, no claims have been amended, no claims have been canceled and no new claims have been added to the application by this amendment. Claims 10 and 14-21 are pending in the application.

In the prior Office Action, the Examiner rejected claims 10 and 14-21 under 35 U.S.C. §102(b) as being anticipated by Yamamoto et al. (U.S. Pat. No. 6,103,387). As noted by the Examiner, Yamamoto et al. teaches a coating composition that includes: an acrylic polyol resin and/or a polyester polyol resin (referred to by Yamamoto et al. as component (A')); one or more compounds selected from the group consisting of a polyisocyanate compound having two or more isocyanate groups per molecule, a polyblocked isocyanate compound having two or more blocked isocyanate groups per molecule and an aminoplast resin (referred to by Yamamoto et al. as component (B')); and a dispersing component of at least one inorganic oxide sol selected from the group consisting of an aluminum oxide sol, a silica sol, a zirconium oxide sol and an antimony oxide sol (referred to by Yamamoto et al. as component (C)) (see col. 25, lines 49-67). The Examiner admits in the prior Office Action that Yamamoto et al. does not teach that the mixture of monomers used to form component (A') should be polymerized in the presence of a non-radical polymerizable organosilicate. Nevertheless, the Examiner contends that in the absence of evidence, the product produced by the process according to

Yamamoto et al. would be the same of the product produced as claimed in claim 10 of the present application because the same ingredients are utilized in both compositions.

Applicants respectfully submit that there appears to be some confusion on the part of the Examiner regarding applicants' stain resistant coating composition as claimed in claim 10. The modified resin component (F') of applicants' claimed stain resistant coating composition has an organosilicate structure part and an acrylic resin structure part. Claim 10 specifies that the modified resin component (F') is prepared by polymerizing a mixture of polymerizable monomers for constructing the acrylic resin structure part in the presence of a non-radical polymerizable organosilicate for constructing the organosilicate structure part. Claim 10 further specifies that the non-radical polymerizable organosilicate for constructing the organosilicate structure part is represented by formula (2):



wherein  $R^3$  and  $R^4$  are each hydrogen atom, an alkyl group having 1 to 10 carbon atoms or an aryl group having 1 to 10 carbon atoms and n is 0 or 1, and/or a condensate thereof. The specification hypothesizes that polymerizing the mixture of polymerizable monomers for constructing the acrylic resin structure part in the presence of the non-radical polymerizable organosilicate for constructing the organosilicate structure part according to formula (2) is useful for orienting component (C), which is an organosilicate according to formula (1), effectively on the surface of the paint film even when the amount of component (C) is small (see specification, at page 28, lines 10-13). Thus, applicants' composition as claimed in claim 10 includes two organosilicates, namely: (1) a non-radical polymerizable

organosilicate according to formula (2) for constructing the organosilicate structure part of modified resin (F'); and component (C), which is an organosilicate according to formula (1). Component (C) of applicants' composition as claimed in claim 10 is not polymerized with the monomers used to form modified resin (F'). A non-radical polymerizable organosilicate according to formula (2) is present when the mixture of polymerizable monomers for constructing the acrylic resin structure part to form modified resin (F'). This distinction is important.

The Examiner concedes that Yamamoto et al. "is silent on" whether a non-radical polymerizable organosilicate should be present when the mixture of monomers is polymerized to form the modified resin component (referred to by Yamamoto et al. as component (A')). But concludes that in the absence of evidence to the contrary, the product according to Yamamoto et al. would be the same as the product according to claim 10. Applicants respectfully disagree.

Contemporaneous with the filing of this amendment, applicants have submitted the Declaration of Yoshinori Nakane under 37 C.F.R. §1.132, which describes a comparative test that proves that a product produced in accordance with claim 10 is not structurally the same as a product produced in accordance with the process described in Yamamoto et al. The test data clearly shows that although the same materials were used in the same amounts in both compositions, the resulting films had different properties (see Table 12), which can only be attributed to the differing processes by which the modified resins were formed. Because the resulting paint films do not exhibit the same properties and include components that were formed by different processes using the same materials, they must be

structurally different products. No other conclusion can be drawn. Application of *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985), is clearly inappropriate in this case.

Also in the prior Office Action, the Examiner states that "the specific advantage of utilizing a monomer of formula (3) is not claimed." Applicants do not understand the point of this statement. Applicants are not required to specify the advantage of utilizing a particular monomer in the claims. Applicants are merely required to describe the components which must be present in the stain resistant coating composition which applicants regard as the invention. Nothing more is required by the patent statutes.

In view of the additional evidence presented by way of the Declaration of Yoshinori Nakane and for the reasons specified herein, reconsideration of the prior rejection of claims 10 and 14-21 as being anticipated by Yamamoto et al is respectfully requested.

Also in the prior Office Action, the Examiner also rejected claims 10 and 14-21 under 35 U.S.C. §102(b) as being anticipated by Nambu (EP 1 013 730) (equivalent to U.S. Pat. 6,316,572) and as being anticipated by JP 11-116847. The Examiner makes the same arguments and contentions regarding these prior art references as were made with respect to Yamamoto et al. In response, applicants direct the Examiner's attention to the following:

(1) Nambu and JP847 do not teach or suggest a stain resistant coating composition that comprises a modified resin, which has an organosilicate structure part and an acrylic resin structure part, and which is prepared by polymerizing a mixture of polymerizable monomers for constructing the acrylic resin structure part in

the presence of a non-radical polymerizable organosilicate for constructing the organosilicate structure part; and

(2) The Declaration of Yoshinori Nakane demonstrates that preparing the modified resin (F') component in the manner claimed in claim 10 results in the production of a product that exhibits unexpected improvements in a stain resistant coating composition. These differences in performance can only be attributed to differences in the end products themselves, and not in the ingredients or amounts of such ingredients used (because they were the same). The different paint films having different properties were obtained by reason of the different processes by which the components used to form the paint films were made. And these novel process limitations are set forth in claim 10.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. ORI-17098.001.

Respectfully submitted,

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